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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/662,230	09/14/2000	Hideo Ando	04329.2387	3095

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FINNEGAN, HENDERSON, FARABOW, GARRETT &  
DUNNER LLP  
1300 I STREET, NW  
WASHINGTON, DC 20006

EXAMINER

FLETCHER, JAMES A

ART UNIT	PAPER NUMBER
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2615

DATE MAILED: 03/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/662,230

Applicant(s)

ANDO ET AL.

Examiner

James A. Fletcher

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 September 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 September 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## **DETAILED ACTION**

### ***Claim Objections***

1. Claim 5 is objected to because of the following informalities: On page 91, the last line of text reads "...contents of said first audio information before divided,". It is the examiner's opinion that the text should read --...contents of said first audio information before **being** divided, --. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 5 and 6 are rejected under 35 U.S.C. 112, first paragraph, because the best mode contemplated by the inventor has not been disclosed. Evidence of concealment of the best mode is based upon the undefined usage of the second, third, fourth, fifth, and sixth audio information. The use and value of these informations is unclear to the examiner. The examiner has interpreted these informations as relating to audio following a still picture as part of a playback sequence. If this interpretation is incorrect, the examiner requests that the applicant provide him with clarification.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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5. Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Wactlar et al (5,835,667).

**Regarding claim 1**, Wactlar et al disclose an information storage medium for recording audio information and still image information recording (Col 16, lines 48-49 the use of disk striping on disk arrays”):

- one or more first reproduction units for reproducing the audio information (Col 3, line 4 “audio can be played”); and
- set information for setting the still image information to represent contents of the first reproduction unit (Col 11, lines 66-67 “Each paragraph may be reasonably abstracted by a ‘representative frame,’”),
- wherein the set information is provided for at least one of the first reproduction units(Col 11, lines 66-67 “Each paragraph may be reasonable abstracted by a ‘representative frame,’”).

**Regarding claim 2**, Wactlar et al disclose an information storage medium wherein the still image information to be displayed first in the first reproduction unit is set as the still image information being representative of the contents of the first reproduction unit (Col 17, lines 52-53 “image processing helped select representative still images for icons and sequences from scenes”).

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application

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by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

7. Claims 3, 7-9, 11-14 are rejected under 35 U.S.C. 102(e) as being anticipated by Maruyama et al (6,453,119).

**Regarding claim 3**, Maruyama et al disclose an information storage medium (Col 1, lines 11-12 an information recording medium") for recording audio (Col 33, lines 3-4 "Audio objects are contents...of audio data"), still image (Col 33, lines 1-3 "Picture objects are still picture information such as still pictures and slide pictures"), and one or more reproduction sequences for reproducing the audio information (Col 23, lines 31-33 "Program chain contents...indicate the number of programs and number of cells...in the program chain"), wherein, in at least one of the reproduction sequences, the still image

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information is displayed at the same time when the audio information is reproduced (Col 9, lines 29-38 "Each video title set stores...audio data...and also information for playing back these data"), the medium recording:

- information for specifying or designating the still image information to represent contents of the reproduction sequence in which the still image information is to be displayed (Col 39, lines 16-17 "representative picture data can be used as a material for an icon").

**Regarding claim 4**, Maruyama et al disclose an information storage medium wherein in a case where the still image information is displayed at the same time when the audio information is reproduced in accordance with the reproduction sequence, the still image information to be displayed first is set as the still image information representing the contents of the reproduction sequence (Col 39, lines 16-17 "representative picture data can be used as a material for an icon").

**Regarding claim 7**, Maruyama et al disclose a method for setting a representative image (Col 39, lines 16-17 "representative picture data can be used as a material for an icon"), wherein the setting method uses an information storage medium (Col 1, lines 11-12 "an information recording medium") for recording audio information (Col 33, lines 3-4 "Audio objects are contents...of audio data"), still image information (Col 33, lines 1-3 "Picture objects are still picture information such as still pictures and slide pictures."), and management information indicative of a reproduction relationship between the audio information and the still image information (Col 23, lines 31-33

"Program chain contents...indicate the number of programs and number of cells...in the program chain"), comprising:

- providing a first reproduction unit for reproducing the audio information (Col 2, lines 62-63 "playing back an information recording medium"); and
- recording, in the management information, information for specifying or designating the representative image of contents of the audio information reproduced in the first reproduction unit (Col 39, lines 16-17 "representative picture data can be used as a material for an icon").

**Regarding claim 8,** Maruyama et al disclose a method for setting a representative image, wherein one or more first reproduction units for reproducing audio information are used, and the setting method uses an information storage medium for recording audio information, still image information, and set information for setting the still image information to represent contents of at least one of the first reproduction units,

- and wherein the still image information to be displayed first in the first reproduction unit is set as the representative image representing the contents of the first reproduction unit (Col 39, lines 16-17 "representative picture data can be used as a material for an icon").

**Regarding claim 9,** Maruyama et al disclose a method for setting a representative image (Col 39, lines 16-17 "representative picture data can be used as a material for an icon"), wherein the setting method uses an information storage medium (Col 1, lines 11-12 "an information recording medium") for recording audio information

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(Col 33, lines 3-4 "Audio objects are contents...of audio data"), still image information (Col 33, lines 1-3 "Picture objects are still picture information such as still pictures and slide pictures."), one or more reproduction sequences for reproducing the audio information (Col 23, lines 31-33 "Program chain contents...indicate the number of programs and number of cells...in the program chain"), and information for specifying or designating the still image information to represent contents of the reproduction sequence in which the still image information is to be displayed (Col 39, lines 16-17 "representative picture data can be used as a material for an icon"),

- and wherein, in a case where the still image information is displayed at the same time when the audio information is reproduced in accordance with the reproduction sequence, the still image information to be displayed first is set as the representative image representing the contents of the reproduction sequence (Abstract "An information recording medium includes a first area for storing picture data...A second area...stores control data...and a third area which ... stores specifying data...for forming a representative picture in the plurality of pictures").

**Regarding claim 11**, Maruyama et al disclose a data structure for recording audio information and still image information, comprising:

- one or more first reproduction units for reproducing the audio information (Col 2, lines 62-63 "playing back an information recording medium"); and



- set information for setting the still image information to represent contents of the first reproduction unit (Col 39, lines 16-17 "representative picture data can be used as a material for an icon").

**Regarding claim 12,** Maruyama et al disclose a data structure wherein the still image information to be displayed first in the first reproduction unit is set as the still image information being representative of the contents of the first reproduction unit (Col 39, lines 16-17 "representative picture data can be used as a material for an icon").

**Regarding claim 13,** Maruyama et al disclose a data structure for recording audio information, still image information, and one or more reproduction sequences for reproducing the audio information, wherein, in at least one of the reproduction sequences, the still image information is displayed at the same time when the audio information is reproduced, the data structure comprising:

- information for specifying or designating the still image information to represent contents of the reproduction sequence in which the still image information is to be displayed (Col 39, lines 16-17 "representative picture data can be used as a material for an icon").

**Regarding claim 14,** Maruyama et al disclose a data structure wherein, in a case where the still image information is displayed at the same time when the audio information is reproduced in accordance with the reproduction sequence, the still image information to be displayed first is set as the still image information representing the contents of the reproduction sequence (Col 39, lines 16-17 "representative picture data can be used as a material for an icon").

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maruyama et al in further view of Kim et al (6,519,415)

**Regarding claim 5**, Maruyama et al disclose a method for setting a representative image, wherein the setting method uses an information storage medium for recording audio information, still image information, and management information indicative of a reproduction relationship between the audio information and the still image information (Col 39, lines 16-17 "representative picture data can be used as a material for an icon"), comprising:

- providing one or more first reproduction units for reproducing the audio information which includes first audio information managed in the first reproduction unit (Col 33, lines 3-4 "Audio objects are contents...of audio data");
- recording, in the management information, a still image being coincident with the representative image of contents of the first audio information before divided, as a representative image of contents of the second audio information and as a representative image of contents of the third audio

information (Col 39, lines 16-17 "representative picture data can be used as a material for an icon").

- Although Maruyama suggests dividing the first audio information managed in the first reproduction unit into second audio information and third audio information reproduced in the first reproduction unit (Col 2, lines 53-60 "a first area for storing...a plurality of pictures...and a third area...for specifying a storage position of representative picture data", they do not specifically disclose the display of multiple pictures during a single audio playback event. However, Kim et al teach of the use of a plurality of pictures being displayed with the playing of an audio recording (Col 2, lines 26-29 "the method linked to the still pictures on a rewritable storage media includes recording obtained still pictures and/or audio signals which will be reproduced together with correspondent still pictures"). As suggested by Maruyama and taught by Kim, being able to play several still pictures in a single audio sequence would provide for a clean, continuous presentation that would not require user intervention to advance from one picture to the next. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to divide the audio information into a sequence of informations, each associated with an individual still picture.

**Regarding claim 6,** Maruyama et al disclose a method for setting a representative image, wherein the setting method uses an information storage medium for recording audio information, still image information, and management information

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indicative of a reproduction relationship between the audio information and the still image information (Col 39, lines 16-17 "representative picture data can be used as a material for an icon").

- Although Maruyama et al suggest providing one or more first reproduction units for reproducing the audio information which includes fourth audio information and fifth audio information managed in the first reproduction unit;
- combining the fourth audio information and the fifth audio information to form sixth audio information reproduced in the first reproduction unit; and
- recording in the management information, the representative image of contents of earlier-reproduced audio information, as a representative image of contents of the sixth audio information, wherein the earlier-reproduced audio information indicates one of the fourth audio information before combining and the fifth audio information before combining, which one is reproduced earlier than the other after combining, (Col 2, lines 53-60 "a first area for storing...a plurality of pictures...and a third area...for specifying a storage position of representative picture data", they do not specifically disclose the display of multiple pictures during a single audio playback event. However, Kim et al teach of the use of a plurality of pictures being displayed with the playing of an audio recording (Col 2, lines 26-29 "the method linked to the still pictures on a rewritable storage media includes recording obtained still pictures and/or audio signals which will be reproduced together with correspondent still pictures"). As suggested by Maruyama and taught by Kim,

being able to play several still pictures in a single audio sequence would provide for a clean, continuous presentation that would not require user intervention to advance from one picture to the next. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to divide the audio information into a sequence of informations, each associated with an individual still picture.

**10.** Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson et al (5,986,701) in further view of Anderson (6,249,316).

**Regarding claim 10,** Anderson et al disclose a method for reproducing audio information having a representative image in a reproduction unit (Col 5, lines 22-23 “capture sequences appropriately considered natural groups include synchronized images with sound”), wherein the reproducing method uses an information storage medium for recording the audio information, still image information, and management information (Fig 3, item 354 “Removable Memory”), the method comprising:

- reproducing the management information to search for one or more representative images (Abstract “The central processing unit further coordinates identification of a first group...provid[ing] structured relationships among images”);
- Although Anderson et al in the 701 patent suggest displaying the one or more searched representative images;
- selecting audio information to be reproduced from the displayed representative images; and

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- reproducing the selected audio information, they do not specifically disclose doing so. However, in the 316 patent, Anderson teaches a system that displays the images (Col 2, lines 55-56 "a user may...display the images in the group"), and select audio to be played (Fig 8, item 414 "Sound" button). Since Anderson both suggests and teaches the use of a plurality of images grouped in a group with an audio file, it would have been obvious to one of ordinary skill in the art at the time of the invention to create a grouping of images and audio for display.

**11.** Any inquiry concerning this communication or earlier communications from the examiner should be directed to James A. Fletcher whose telephone number is (703) 305-3464. The examiner can normally be reached on 7:45AM - 5:45PM M-Th, Alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Christensen can be reached at (703) 308-9644.

**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

Washington, DC 20231

**or faxed to:**

**(703) 872-9314 (for Technology Center 2600 only).**

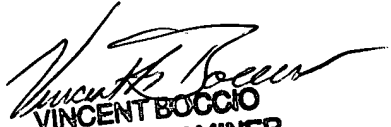
Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA Sixth Floor (Receptionist).

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.

JAF  
February 25, 2003

  
VINCENT BOCCIO  
PRIMARY EXAMINER